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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,989	02/02/1999	MASARU SUZUKI	250152-1020	9403
24504 7590 06/15/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER DUONG, THOI V	
			ART UNIT 2871	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/241,989

Applicant(s)

SUZUKI ET AL.

Examiner

Thoi V. Duong

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,13,15-19 and 42-66 ~~is/are~~ pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-7,13,15-19 and 42-50 ~~is/are~~ allowed.
- 6) ☒ Claim(s) 51-66 ~~is/are~~ rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 121,657.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) None
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the Amendment filed June 22, 2006.

Accordingly, claims 1, 6, 7, 13, 42, 43, 46 and 49 were amended, claims 2, 8-12, 14 and 20-41 were cancelled, and new claims 61-66 were added. Currently, claims 1, 3-7, 13, 15-19 and 42-66 are pending in this application.

2. The declaration under 37 CFR 1.132 filed on January 04, 2006 is insufficient to overcome the rejection of claims 51-60 based upon insufficiency of disclosure under 35 U.S.C. 112, first paragraph as set forth in the last Office action because: the declaration fails to set forth facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112. Expert opinion as to a legal conclusion is not entitled to any weight (see MPEP 716.01(c)).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 51-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The figure that shows "pitch=150+/-10 micrometer" still shows a pitch which can be selected to be from 140-160 micrometer, not multiple pitches between peaks or a variation of pitches between adjacent prisms.

Art Unit: 2871

Those of ordinary skill would have recognized this as it is stated that the pitch (a single pitch) should be set at 150 micrometer plus or minus 10 micrometer, not that there should be different pitches from prism to prism. Further, no description of how or why the pitch is varied. Because of the lack of any explanation for how, why or in what way the pitch should be varied and the figure description being the common way of indicating a single pitch, one of ordinary skill would have found that applicant was not in possession of the invention having multiple pitches a variation of pitches between adjacent prisms. The language does not exclude the possibility of variations, however it does not provide description of variations in pitch from prism to prism.

5. Claims 51- 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As applicant has not provided even a single example showing how the pitch is to be varied, or explained what it is to be varied for, those of skill in the art would have no way to set how or where to vary the pitch, in fact they would not know if they achieved the invention of applicants as no goal or example has been presented. As none had a pitch variation as claimed, and applicant has given no indication of how or why the pitch should be varied, without known why they are doing it, or how it should be done, they would not be able to make a variation which would work for any purpose.

***Allowable Subject Matter***

6. Claims 1, 3-7, 13, 15-19 and 42-50 are allowed.

Art Unit: 2871

The following is an examiner's statement of reasons for allowance: none of the prior art of record fairly suggests or shows all of the limitations as claimed. Specifically,

Re claims 1, 3, 6, 13, 42, 43, 46 and 49, none of the prior art of record discloses, in combination with other limitations as claimed, a polarizer positioned between the liquid crystal display panel and the optical film, and a direction along which the peaks and valleys of the isosceles triangle prisms are oriented is aligned in parallel to a polarizing axis of said polarizer and the tops of the isosceles triangle prisms are not farther than 160 micrometer apart.

The most relevant references, US 5,442,523 to Kashima et al. (Kashima) and JP 01-131010 to Kaneko et al. (Kaneko), fail to disclose or suggest the claimed invention. The references only discloses an optical film including a first surface having a wave structure including a plurality of regularly spaced isosceles triangles prisms arranged side-by-side, the prisms having smooth surfaces, and a second surfacing having an optically rough structure for performing diffuse transmissions, wherein a top angle of said isosceles triangle prisms is in a range of 90 degrees to 110 degrees and wherein the tops of the isosceles triangle prisms (pitches) are from 10 to 1000 micrometer apart.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

7. Applicant's arguments filed June 22, 2006 have been fully considered but they are not persuasive.

Re claims 51-60, Applicant argued that the subject matter of claims 51-60 should not be considered new matter for at least the reason that, as illustrated in Exhibit A filed January 04, 2006, that one skill in the art, upon reading the present application would understand the present application to include the subject matter that the Office Action asserts as new matter. The Examiner disagrees with Applicant's remarks since the subject matter is still not adequately supported by the prior patent. The patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor has possession of the claimed invention (see MPEP 2163).

In fact, the figure that shows "pitch=150+/-10micrometer" still shows a pitch which can be selected to be from 140-160 micrometer, not multiple pitches between peaks or a variation of pitches between peaks. Those of ordinary skill would have recognized this as it is stated that the pitch (a single pitch) should be set at 150 plus or minus 10 micrometer, not that there should be different pitches from prism to prism. Further, no description of how or why the pitch is varied. Because of the lack of any explanation for how, why or in what way the pitch should be varied and the figure description being the common way of indicating a single pitch, one of ordinary skill would have found that applicant was not in possession of the invention having multiple pitches or a variation of pitches between the tops of adjacent prisms.

**Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thoi V. Duong whose telephone number is (571) 272-2292. The examiner can normally be reached on Monday-Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms, can be reached at (571) 272-1787.

Thoi V. Duong



06/01/2007